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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: James R. Patterson  
Serial No.: 09/747,852  
Filed: December 22, 2000  
For: Magnetic Plumb Bob Holder

June 17, 2004  
Group Art Unit 2859  
Examiner: Travis M. Reis

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF  
PATENT APPLICATION (37 C.F.R. 1.192)

1. Transmitted herewith, in triplicate, is a SUPPLEMENTAL APPEAL BRIEF in this application, with respect to the Notice of Appeal filed on January 21, 2003.
2. STATUS OF APPLICANT. This application is on behalf of a small entity. A statement was previously filed.
3. FEE FOR FILING APPEAL BRIEF. Pursuant to 37 C.F.R. 1.17(c), the fee for filing the Appeal Brief is \$160.00 for a small entity. The fee was transmitted with Appellant's brief filed May 19, 2003.
4. EXTENSION OF TERM. The fee for a one month extension of time (37 CFR 1.17(a)) to file the Appeal Brief is \$55.00.
5. FEE PAYMENT. Please charge the amount of \$55.00 to Deposit Account No. 06-1090.

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6. FEE DEFICIENCY. If any additional extension and/or fee is required, this is a request therefor and the Commissioner is authorized to charge the appropriate fee(s) to Deposit Account No. 06-1090.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 17, 2004.



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Grace J. Fishel



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Serial No.: 09/747,852  
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Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S SUPPLEMENTAL BRIEF (37 C.F.R. 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this case on January 21, 2003 against the objection to and rejection of claims 1 and 11, claims 6 through 10 and 12 through 16 having been allowed. Appellant filed an appeal brief, on May 19, 2003, which resulted in the Final Rejection of claims 1 and 11 being withdrawn and the application being returned to continued prosecution.

In the Official Action of July 22, 2003 the Examiner found claims 1 and 6 through 16 to be allowable on the merits and entered a Quayle Action asserting various informalities. Agreement has not been reached and it is respectfully requested that the appeal be reinstated.

The appeal fees required under 37 C.F.R. have been transmitted with Appellant's brief filed May 19, 2003 and with Appellant's Notice of Appeal. Any fee required for a petition for extension of time for filing this brief is dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief is transmitted in triplicate. (37 C.F.R. 1.192(a)).

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This brief contains these items under the following headings, and in the order set for the below (37 C.F.R. 1.92(c)):

- I      REAL PARTY IN INTEREST
- II     RELATED APPEALS AND INTERFERENCES
- III    STATUS OF CLAIMS
- IV    STATUS OF AMENDMENTS
- V    SUMMARY OF THE CLAIMED INVENTION
- VI    ISSUES
- VII   GROUPING OF CLAIMS
- VIII   ARGUMENTS
  - ARGUMENT:       VIII A OBJECTIONS UNDER 35 U.S.C. 112,  
FIRST PARAGRAPH
  - ARGUMENT:       VIII B REJECTIONS UNDER 35 U.S.C. 112,  
SECOND PARAGRAPH
  - ARGUMENT:       VIII C REJECTIONS UNDER 35 U.S.C. 102
  - ARGUMENT:       VIII D REJECTIONS UNDER 35 U.S.C. 103
  - ARGUMENT:       VIII E REJECTIONS OTHER THAN 35 U.S.C.  
102, 103 AND 112

#### APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

#### OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR DESIRABLE.

The final page of this brief bears the practitioner's signature.

#### I    REAL PARTY IN INTEREST (37 C.F.R. 1.192(c)(1))

The real party in interest in this appeal is the party named in the caption of this brief.

## II RELATED APPEALS AND INTERFERENCES (37 C.F.R. 1.192(c)(2))

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

## III STATUS OF THE CLAIMS (37 C.F.R. 1.192(c)(3))

The status of the claims in this application are:

### A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application as filed are: Claims 1 through 16.

### B. STATUS OF THE CLAIMS

1. Claims canceled: Claims 2 through 5 and 11.

2. Claims withdrawn from appeal: None.

3. Claims pending: Claims 1, 6 through 10 and 12 through 16.

4. Claims allowed: Claims 1, 6 through 10 and 12 through 16 are allowed over the art of record.

5. Claims rejected: None.

6. Claims objected to: Claims 1, 6 and 15.

### C. CLAIMS ON APPEAL

The claims on appeal are Claims 1, 6 and 15.

## IV STATUS OF AMENDMENTS (37 C.F.R. 1.192(c))

A. Appellant's Amendment A of July 5, 2002, in response to the non-final Official Action of March 4, 2002, was entered amending claim 1 and canceling claims 2 through 5. No rejections or objections of the claims, under 35 U.S.C. 112, were entered in the non-final action of March 4, 2002. Minor changes to the specification were entered in response to the Examiner's request in the Official Action of March 4, 2002.

B. Appellant's Response B was filed September 27, 2002, in response to the Final Rejection of August 30, 2002. Appellant's response submitted arguments, without any amendment to the claims, in response to new grounds of

argument and new grounds of rejection of independent claim 1 raised in the Final Rejection of August 30, 2002. All of claims 6 through 16 were allowed in the Final Rejection of August 30, 2002, without objection.

C. Subsequently, the Final Rejection of August 30, 2002 was withdrawn and a new Final Rejection was entered October 18, 2002 against independent claim 1 and previously allowed claim 11 (depending from allowed claim 6). The new Final Rejection included new grounds of argument and entered new grounds of rejection under 35 U.S.C. 103 against claim 1 and new grounds of objection, under 35 U.S.C. 112, second paragraph, against claim 1 and claim 11. The new grounds of rejection was based on the new application of Walters et al. (U.S. patent No. 5,933,974) in view of Lee et al. (U.S. patent No. 5,426,860) and entered new arguments based on this newly applied combination of references.

Appellant's Amendment C was filed November 18, 2002 in response to the new grounds of argument and new grounds of rejection and objection raised for the first time in the Final Rejection of October 18, 2002 (directed against claims 1 and 11), including new grounds of objection under 35 U.S.C. 112. Appellant's Amendment C made formal amendments to claim 1 in response to the objection of claim 1 under 35 U.S.C. 112. The amendment of Appellant's Amendment C has not been entered.

The Advisory Action of November 27, 2002 refused entry of Appellant's Amendment C stating: The amendments raise new issues that would require further consideration and/or search. The amendments are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

D. On January 21, 2003 Applicant appealed from the Final Rejection of October 18, 2002. Appellant's Brief on Appeal was filed May 19, 2003. On July 22, 2003 the Final Rejection of October 18, 2002 was withdrawn, prosecution of the application was reopened, and an Official Action was issued under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213. The Quayle Action of July 22, 2003 objected to the drawings and requested that the drawings be amended to show the storage feature

claimed in original claims 13 and 15. The Quayle Action further objected to the specification as failing to provide proper antecedent basis for the claimed subject matter, stating: Correction of the following is required: The specification does not clearly state what structural features of the invention provide the means for assessing the true status of a frame in relation to three dimensional space as stated in claims 1, 6 & 15. The Quayle Action also requested that "magnet" be changed to "magnetic", in claim 6, line 2, and that "status" should be added after "true" in claim 6, line 9. A further change of an "a" to a "the" was requested for claim 11, line 1.

On December 22, 2003 Applicant filed Amendment D in response to the Quayle action of July 22, 2003. Appellant's Amendment D made the requested amendments to claim 6 and canceled claim 11 to simplify the issues. Amendment D made the requested addition to Figure 3 of the Drawing and added reference numerals 48 and 62 to Figure 3, as found in Figure 5. Amendment D also added reference numeral 44 to Figure 5, as found in Figure 2 (see the attached red lined drawing copies). Additional corrections were made to the specification to place the application in condition for allowance. The specification was corrected to show the best Figure number, at two places, and a reference number was corrected, at two places.

Further, to provide the requested antecedent basis, page 3, lines 24 and 25, of the specification were amended to read as follows, "Relieved areas 22, 24, and 26 may be used for storing the string of a plumb bob, by wrapping, and a plumb bob 48 may thus be stored in the space between flanges 18 and 20." Antecedent basis for the amendment to page 3 of the specification is found in original claim 13, lines 2 - 4, "...the first and second flanges being spaced to receive a plumb bob stored therein and the recesses receiving the string of a plumb bob wound thereon." Further antecedent basis is found in claim 15, lines 9 - 10, "... the first and second flanges defining a space therebetween to receive a plumb bob therein."

Amendment D included an amendment to claim 1 to clarify the means term used in that claim. Amendment D also called the Examiner's attention to the structural nature of claims 6 and 15, which do not contain means terms. Applicant referred the Examiner to the specification and the Drawings, in detail, where the

invention is described and meets the requirements of 35 U.S.C. 112, paragraph 6. See page 3, line 29, through page 4, line 14, of the specification; claim 13 lines 2 through 4 and claim 15, lines 10 through 12.

On April 20, 2004 the Examiner issued an Advisory Action refusing entry of all of the amendments filed in Appellant's Amendment D.

V SUMMARY OF THE CLAIMED INVENTION (37 C.F.R. 1.192(c)(5))

Appellant's invention is a unique tool for gauging the true of installed steel door frames. The tool quickly and easily allows an inspector to gauge the true of a door frame in three dimensional space. That is, the tool gauges the true of the steel door frame in both the X -- Y plane and in the Y -- Z plane.

As disclosed in the Specification and the Drawings, and as claimed in original independent claim 6 and its dependent claims, the tool provides structure which allows an inspector to use the tool to make the determination of the true status of an installed steel door frame 54. This structure includes the reference plane defined by the magnetic attachment 40 of the base 12, the flange 18 defining an additional reference plane, and a second flange 20 spaced from and parallel to the flange 18.

The flanges 18 and 20, and the cavity between the spaced flanges 18 and 20, provide structure which allows a plumb bob 48 to be stored in the tool, if desired, and as disclosed in original claims 13 and 15, for example.

The disclosed structure allows the device to be positioned in a particular gauging relationship to a steel door frame 54, as shown in Figures 5 and 6. When so positioned, the tool may cooperate with a string 62 and a plumb bob 48 to quickly provide the information about the true status of the steel door frame 54 by modeling the dimensions of the door frame.

As claimed in claim 1 and as permitted by 35 U.S.C. 112, paragraph 6, the disclosed tool is defined in means plus function terms. Claim 1 also claims the combination of the tool with a plumb bob 48 and claims the storage of the plumb bob 48 in means plus function terms.

## VI ISSUES (37 C.F.R. 1.192(c)(6))

Whether claims 1, 6 and 15 are informal as being based on an insufficient disclosure under 35 U.S.C. 112, paragraph 1.

## VII GROUPING OF THE CLAIMS (37 C.F.R. 1.192(c)(7))

Group 1: Claim 1 (amended)

Group 2: Claims 6 and 15 (original).

## VIII ARGUMENTS

### VIIIA ARGUMENTS, OBJECTIONS AND REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH (35 C.F.R. 1.192(c)(8)(i))

The claims on appeal were objected to under 35 U.S.C. 112, first paragraph, hence there are issues on appeal under this heading.

Group 1: Claim 1 has been objected to as having no antecedent basis in the specification under 35 U.S.C. 112, paragraph. The Examiner has stated that the specification does not clearly state what structural features of the invention provide the means for assessing the true status of a frame in relation to three dimensional space as stated in claim 1. Claim 1 contains several means terms, as permitted by 35 U.S.C. 112, paragraph 6. The Examiner has requested that a specific means be identified in the specification. Applicant respectfully traverses the Examiner's request as being non-statutory and improper under the Patent Laws, 35 U.S.C. et seq. 35 U.S.C. 112, paragraph 6 specifically states that claims incorporating means terms shall be construed to cover the corresponding structure described in the specification and the equivalents thereof. Applicant has referred the Examiner to the specification, for example to page 3, line 29, through page 4, line 14, where ample structure is disclosed. Further, original claims 13 and 15 contain structural elements which perform the functions recited by the means terms in claim 1. The Drawing figures, including Figure 5, provide additional disclosure. It is respectfully submitted that claim 1 is fully supported and is not objectionable.

Group 2: Independent claims 6 and 15 have been objected to as having no support in the specification. The Examiner has stated that the specification does not clearly state what structural features of the invention provide the means for assessing the true status of a frame in relation to three dimensional space as stated in claims 6 and 15. Applicant respectfully traverses the Examiner's holding as being non-statutory and improper under the Patent Laws, 35 U.S.C. et seq. As has been pointed out to the Examiner, claims 6 and 15 contain no means terms. Claims 6 and 15 have only structural terms. Claims 6 and 15 are original claims which contain no amendments. Claims 6 and 15 are part of the original specification. There are no features, in means terms or in structural terms, which are not part of the specification and which do not have a proper antecedent basis in the specification. It is respectfully submitted that claims 6 and 15 are not objectionable.

VIIIB ARGUMENTS - OBJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH (37 C.F.R. 1.192(c)(8)(ii))

The claims on appeal were not rejected or objected to under 35 U.S.C. 112, second paragraph, hence there are no issues on appeal under this heading.

VIIIC ARGUMENTS - REJECTIONS UNDER 35 U.S.C. 102 (37 C.F.R. 1.192(c)(8)(iii))

The claims on appeal were not rejected under 35 U.S.C. 102, hence there are no issues on appeal under this heading.

VIIID ARGUMENTS - REJECTIONS UNDER 35 U.S.C. 103 (37 C.F.R. 1.192(c)(8)(iv))

The claims on appeal were not rejected under 35 U.S.C. 103, hence there are no issues on appeal under this heading.

VIIIE ARGUMENTS - REJECTIONS OTHER THAN 35 U.S.C. 102, 103 AND 112 (37 C.F.R. 1.192(c)(8)(v))

There are no further issues on appeal.

IX APPENDIX OF THE CLAIMS (37 C.F.R. 1.192(c)(9))

1 (amended). A tool for inspecting and gauging the accuracy of an installed steel door frame structure, the tool having means for removable attachment to a frame, the attachment means including a magnet, the tool also having means for gauging the condition of the frame in relation to a true status, the gauging means including a plumb bob, the tool having means for storing the plumb bob within the tool, the gauging means including means for assessing the true status of a frame in relation to three dimensional space.

5           6 (original). A tool for inspecting the accuracy of installed steel door frames, the tool having a base with a magnetic attachment therein, the magnet attachment having a terminal portion defining a first reference plane, the tool further having a first flange extending from the base, the first flange having an outer surface defining a second reference plane, the tool having a second flange extending from the base, the second flange being spaced from the first flange and being parallel to the first flange, the second flange having an aperture therethrough, the aperture accepting the string of a plumb bob, the tool cooperating with a plumb bob and string received in the aperture, when attached to an installed steel door, to gauge the accuracy and 10          true of the installed steel door in relation to three dimensional space.

7 (original). The tool of claim 6 wherein the magnetic attachment of the tool includes a pair of spaced magnetic bars.

8 (original). The tool of claim 7 wherein the terminal portions of the spaced magnetic bars define the first reference plane.

9 (original). The tool of claim 8 wherein the magnetic bars have marginal steel plates.

10 (original). The tool of claim 9 wherein the edges of the steel plates define the first reference plane.

12 (original). The tool of claim 6 wherein the tool includes additional calibration means.

13 (original). The tool of claim 6 wherein the first flange has terminal ends, the ends each having a recess therein, the first and second flanges being spaced to receive a plumb bob stored therein and the recesses receiving the string of a plumb bob wound thereon.

14 (original). The tool of claim 6 wherein the tool has additional gauging means.

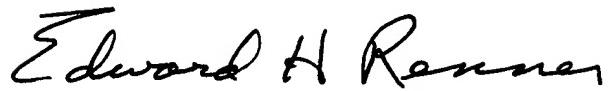
15 (original). A tool for inspecting the accuracy of the installation of magnetic frames, the tool having a base with a magnetic attachment therein, the magnetic attachment including a pair of spaced magnetic bars, the magnetic bars having steel core plates at the sides of the magnetic bars and wherein the steel plates have terminal edges, the edges of the steel plates defining a first reference plane, the tool further having a first flange extending from the base, the first flange having an outer surface defining a second reference plane, the tool having a second flange extending from the base, the second flange being spaced from the first flange, the first and second flanges defining a space therebetween to receive a plumb bob therein, the first flange having terminal ends, the ends each having a recess therein, the recesses receiving a string of a plumb bob when wound therein, the second flange having an aperture therethrough, the aperture accepting the string of a plumb bob, the tool cooperating with a plumb bob and string received in the aperture when attached to an installed magnetic frame to gauge the accuracy and true of the installed magnetic frame in relation to three dimensional space.

16 (original). The tool of claim 15 wherein the frame is a steel door frame.

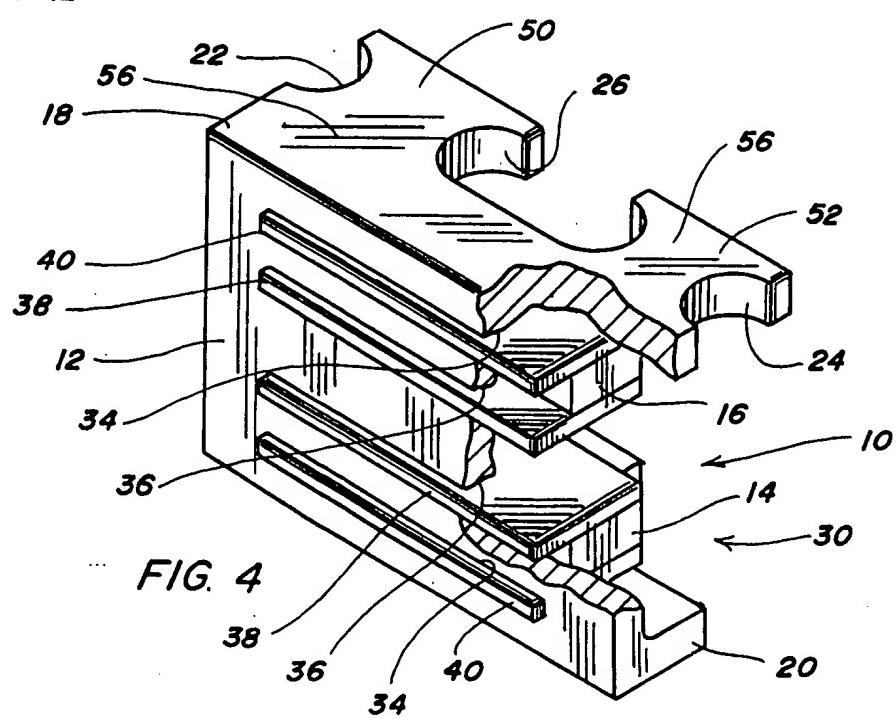
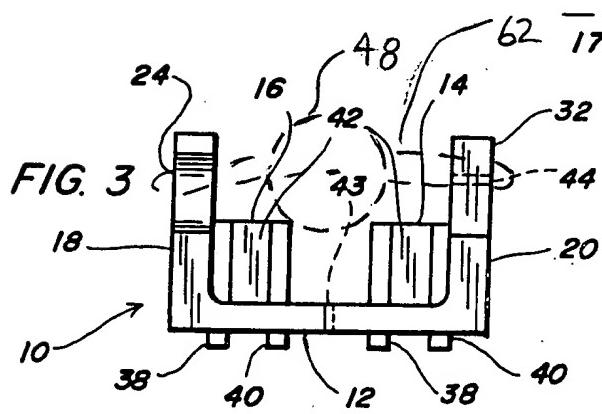
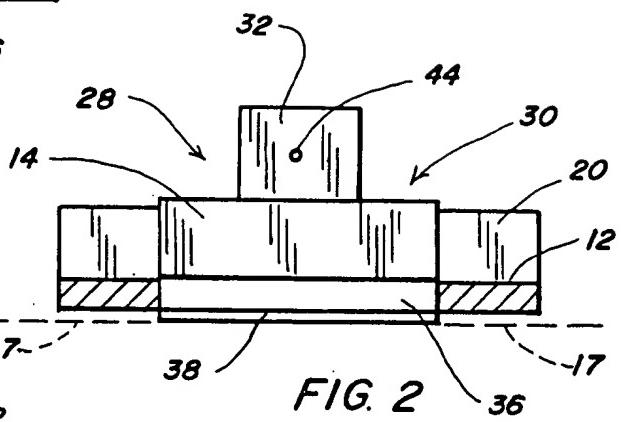
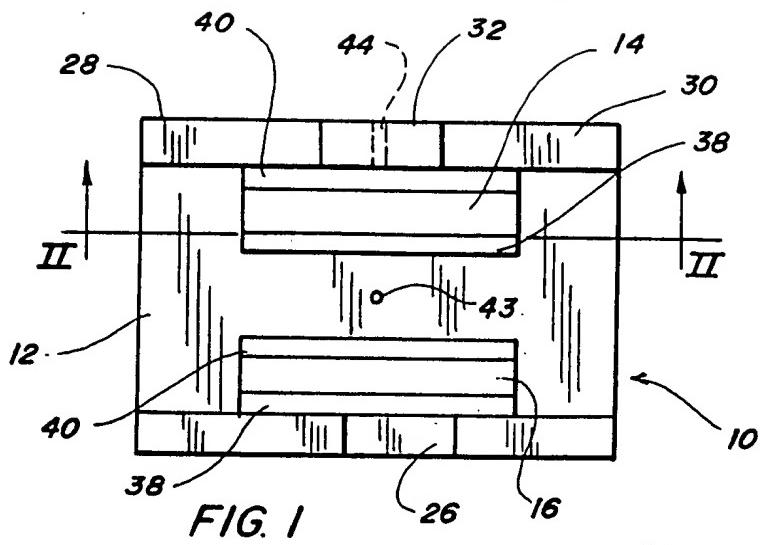
OTHER MATERIALS THAT APPELLANT CONSIDERS NECESSARY OR  
DESIRABLE

The attached red lined copies of appellant's proposed amendments to the drawings are believed to be desirable in consideration of this appeal.

Respectfully submitted,



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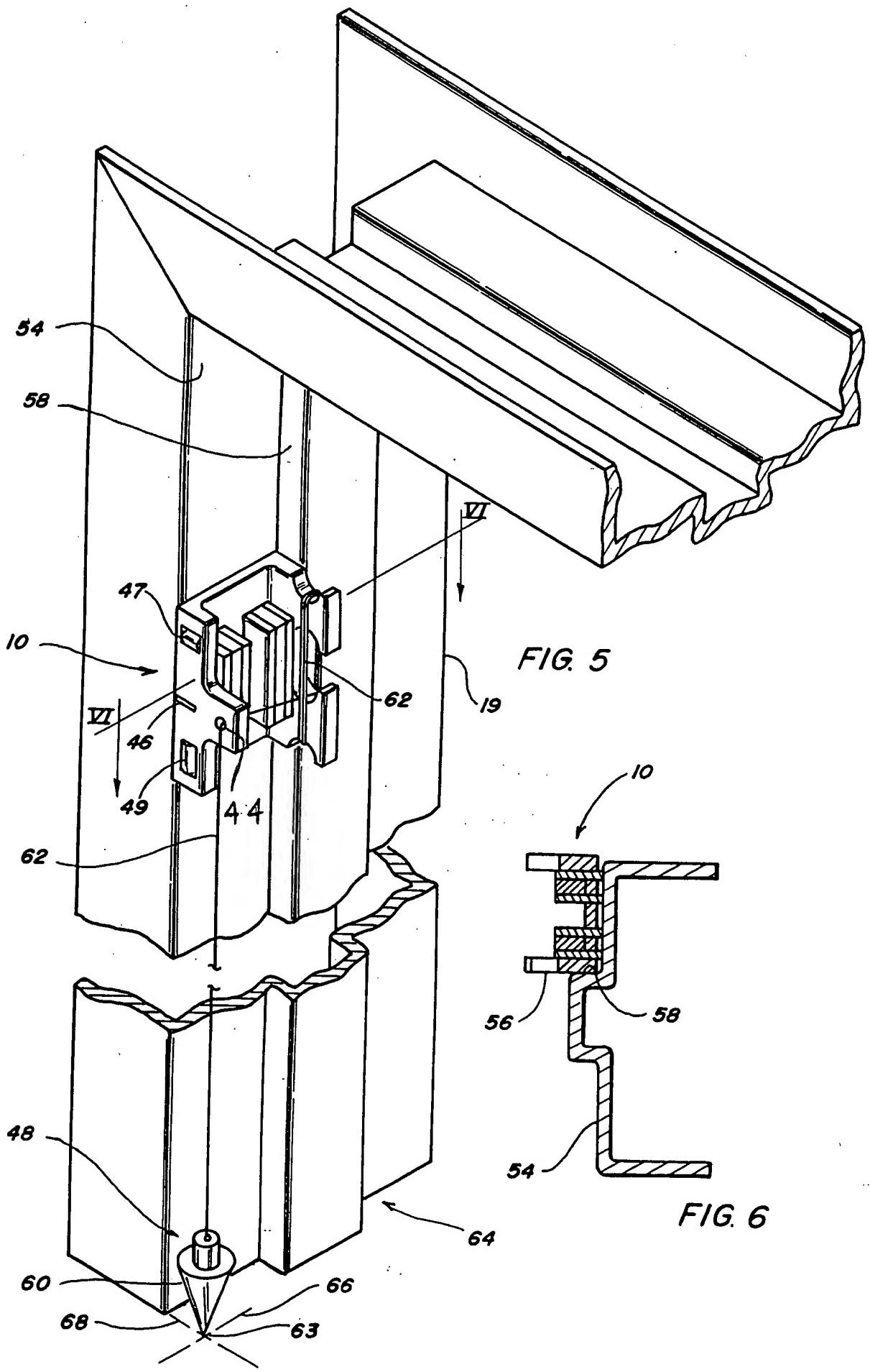


FIG. 5